REMARKS

Claims 1-6, 8-19, 22, 24-32, 38 and 39 are pending in this application. Claim 38 has been amended by this Amendment.

The Office Action dated January 12, 2007 objected to claim 38 because of an informality. The Office Action also rejected claims 38 and 39 as being anticipated by Kari; and rejected claims 38 and 39 as being obvious over Deakin in view of Cobo. Applicants gratefully acknowledge the allowance of claims 1-6, 8-19, and 22-32.

Objection

Applicants have amended claim 38 to overcome the informality noted in the objection. Specifically, applicants have made the correction suggested in the objection of inserting "in" between "the charging identification" and "the call records" in line 8 of the claim. Although the Office Action was made final, applicants request that this amendment be entered since it merely makes the correction requested in the objection and does not affect the allowability of the claim.

Claims 38 and 39

Anticipation Rejection

The grounds for the anticipation rejection of claims 38 and 39 is set forth in part 3 on pages 2-5 of the Office Action. Specifically, the rejection asserts that the claims are anticipated by the GSM/GPRS network shown and described in PCT Patent Document No. WO 97/26739 to Kari et al (this network hereinafter referred to simply as "Kari"). Further comments on the anticipation rejection appear on pages 15-17 of the Office Action. Applicants respectfully traverse the anticipation rejection on the grounds that it fails to establish a prima facie case that Kari includes a network element having each and every one of the combination of features recited in claim 38 or each and every one of the combination of features recited in claim 39.

Application Layer and Transport Layer Networks

For example, claims 38 and 39 include several features related to an application layer network, or to distinguishing an application layer network connection from a transport layer network connection. Many of the comments in the anticipation rejection result from a failure

to properly interpret and consider the application layer network related features recited in the claims. Indeed, the Response to Arguments (on pages 15-16) states that what consists an application layer network and transport layer network "are not recited in the rejected claim(s)"; that "none of the claims clearly and positively recites what is 'an application layer network' or a 'transport layer network'"; that "none of the claims clearly and positively recites how these connections are setup over undefined networks"; and that "no specificity [of these features] are being claimed" (underlining in original).

It is not appropriate to refuse to consider the application layer network and related features recited in the claims, or to require that the claims themselves include the definition of the term. Moreover, it is not appropriate to require that applicants include further specificity of how connections with the transport layer network and the application layer network are setup, or other features. The appropriate analysis is to faithfully interpret the terms used in the claims.

Once again, it is noted that the original specification and drawings of this application define the transport layer network, and also define the application layer network (as part of the architecture of an IP-based telephony network). See, for example, page 12, line 5, to page 14, line 5, of the specification. Thus, an application layer network can provide the same service with different transport layer networks, and with different transport bearers. The transport layer network and application layer network are thus defined to be independent of each other, with each network comprising different network elements.

Kari is directed to a method of billing what it refers to as "new" types of billing for GPRS service in a GSM network. The Kari patent is concerned with accomplishing any one of different types of billing for packet radio networks, such as GPRS. There is no indication that there is an application layer network in Kari.

The rejection erroneously alleges that the "combined system of near end MS, MSC, GGSN, SGSN, HLR Interent and far end MS" in Kari comprises a transport layer network and that the "combined system of near end MS, MSC, GGSN, SGSN, HLR Internet and far end MS" in Kari comprises an application layer. This is incorrect. There is no IP-based telephony network, and thus no application layer network in Kari. The billing done in Kari occurs entirely within the transport layer network. The Response to Arguments (at bottom of page 16) asserts that the application layer network related features can be found in Kari, however the noted parts relate to the GSM/GPRS transport layer network.

Charging Identification

The rejection reads the IMSI identifier of the mobile station (MS) in Kari on the charging identification recited in claims 38 and 39. However, the IMSI is merely a known equipment identifier and is not a charging identification. The IMSI identifier is an attribute of the subscriber's equipment and is used merely to identify the subscriber's equipment. It is typically used for purposes other than charging, such as identifying the subscriber as being authorized to access the GSM/GPRS network. The rejection asserts that the IMSI is "asserted/created and used" as a charging ID, but there is simply no indication to that effect in the patent. The IMSI identifier is permanently linked to the subscriber's equipment and is fixed by the subscriber's equipment.

Furthermore, the IMSI identifier is not used to coordinate charging information between an application layer network and a transport layer network. The BGGSN does not perform any coordination of charging information for different network elements in Kari, much less one network element in an application layer network and another network element in the transport layer network.

Obviousness Rejection

The grounds for the obviousness rejection of claims 38 and 39 is set forth in part 5 on pages 5-9 of the Office Action. Specifically, the rejection asserts that the claims are rendered obvious by the GSM/GPRS network shown in Figs. 1 and 2 of U.S. Patent No. 6,463,275 to Deakin (this network hereinafter referred to simply as "Deakin") in view of U.S. Patent No. 6,496,690 to Cobo. Applicants respectfully traverse the obviousness rejection on the grounds that it fails to establish that the applied references teach a network element having each and every one of the combination of features recited in the rejected claims.

The Deakin and Cobo patents are concerned with how to implement pre-paid billing in a GSM/GPRS. Deakin is directed to a method of billing in a GSM/GPRS network that facilitates various types of billing, such as hot billing (real-time billing) and pre-paid billing, in addition to normal billing. Deakin proposes that a subscriber or subscription specific Billing Class Identifier (BCI) be implemented as a new parameter in the Home Location Register (HLR) and used by a charging gateway to direct billing information to one of several

different billing systems (see, for example, Fig. 2 and col. 2, lines 27-43, and col. 3, lines 24-37).

Same User Equipment Establishes First and Second Network Connections

Claims 38 and 39 recite that the same user equipment establishes both connections recited in the claims. In Deakin, the same user equipment does not establish two connections as recited in amended claims 38 and 39. The rejection itself refers to a "near end TE" and a "far end TE" as two different terminal equipments. Even though Deakin may have two connections, it does not have one connection in a transport layer network and another connection in an application layer network as recited in the claims.

Application Layer Network

The Response to Arguments on pages 10-11 concludes (wrongly) that because Deakin is a GSM/GPRS network, Deakin must necessarily have an application layer. This is quite incorrect. Applicants refer to the discussion of this claim term in the traversal of the anticipation rejection above.

Charging Identification

Claim 38 further recites that the network element is configured to "send said charging identification from said network element so as to be used by a further network element in the other one of the application layer network or the transport layer network..." Claim 39 conversely recites that the network element is configured to "receive said charging identification from a further network element operable in the other one of the application layer network of the transport layer network..."

The network element of claim 38 is configured to create "a charging identification". The rejection asserts that the Billing Class Identifier (BCI) in Deakin is such a charging identification and is generated at the NEs when the connection is requested/initiated for billing/charging. However, the description at col. 4, lines 14-50, of the patent states that the BCI is stored in the HLR and is just one parameter in the subscription data. There is simply no indication that the GGSN or SGSN in Deakin generates the BCI. Indeed, it is the Call Detail Records (CDRs) rather than the BCI that are generated by the GGSN or the SGSN (see col. 1, lines 58-63, and col. 3, lines 24-33, of the patent).

The rejection acknowledges that Deakin does not explicitly disclose these features, but asserts that they are taught by the Cobo patent. Specifically, the rejection asserts that it would have been obvious to send a charging ID to a GGSN node in the system of Deakin "so that it would provide a standardized method of providing a near real time account balance for subscriber's account and stopping the service when the balance reaches to zero; see Cobo col. 2, lines 5-14, 15-56; see col. 3, lines 34-39." When the applied references are considered as a whole, they do not suggest selectively modifying Deakin to include a small part of Cobo as proposed in the rejection.

The Cobo patent identifies a disadvantage that "there is no known method of providing prepaid subscriber service in a packet-switched network" and suggests it would be advantageous to have a standardized system and method of providing prepaid subscriber service in both circuit-switched and packet-switched radio telecommunications networks. (see col. 2, lines 6-12) Therefore, the teaching of the Cobo patent is applicable to the GPRS system in Deakin **if and only if** Deakin does not include a method of providing prepaid susbscriber service. However, Deakin does include a method of providing a prepaid subscriber service (see Figs. 4, 5 and 7; col. 2, lines 45-52; and col. 3, line 51, to col. 4, line 54). Indeed, the Deakin patent itself teaches the advantage of providing pre-paid billing (see col. 1, lines 12-23) and col. 2, lines 57-67).

Thus, the Cobo and Deakin patent both identify the same disadvantage in the same prior art and both suggest a solution to it. The Deakin patent was filed on January 31, 2000 and was not issued (or otherwise made public) until October 8, 2002. The Cobo patent was filed on May 7, 1999 and was not issued (or otherwise made public) until December 17, 2002. In essence, each patent identified the same disadvantage in the same prior art and each patent proposed its own unique solution to that problem. One of ordinary skill in the art being aware of the two patents would adopt the whole of the solution proposed in one or the other of the patent, but to say (as the rejection does) that the Cobo patent teaches an improvement to the Deakin patent is incorrect. It thus would not be obvious to selectively modify the solution set forth in Deakin to include the small portion of the solution set forth in the Cobo patent in the manner evidently proposed in the rejection. The Response to Arguments (on pages 13-14) argues that the combination would have been obvious to one of ordinary skill in the art but does not address these considerations.

Secondly, the Create PDP Context Request 83 in the Cobo patent is sent from the

SGSN to the GGSN. The SGSN and GGSN in the Cobo patent are both in the transport layer network. The rejection thus does not establish the Cobo patent sends a charging identifier from an element in one network to an element in the other network.

Coordinating Charging Information

Claim 38 recites that the charging identification is sent "to enable charging information for the elements to be coordinated." Claim 39 similarly recites that the charging identification is received "to enable charging information for the elements to be coordinated."

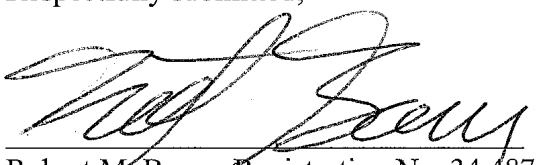
In Deakin, the Billing Class Identifier is used to identify the billing class and to forward CDR's to the correct one of multiple billing systems. The network element NE2 passes CDRs with BCI to a charging gateway, which directs CDRs based on the BCI to the respective billing system. The charging gateway thus uses the BCI to determine whether the billing information is sent to billing system A, B or C. The BCI is not used to coordinate charging information between a transport layer network and an application layer network. The billing method in Deakin occurs entirely within the GSM/GPRS transport layer network.

Conclusion

Applicants respectfully traverse the rejections of claims 38 and 39 for at least the reasons given above and respectfully request a Notice of Allowance.

It is believed that no fees are due. However, if any fees are necessary for the consideration of this Amendment, the Commissioner is hereby authorized to charge such fees to Deposit Account No. 10-0100 (Dkt. No. NOKIA.30US).

Respectfully submitted,



Robert M. Bauer, Registration No. 34,487
Lackenbach Siegel, LLP
Lackenbach Siegel Building
One Chase Road
Scarsdale, NY 10583
Tel.: (914) 723-4300